

REMARKS

I. Status of the Claims

Claims 1-19, 21-69, and 71-99 are pending in this application. Claims 20 and 70 have been cancelled without prejudice or disclaimer. Claims 1 and 51 have been amended to clarify that the composition comprises at least two ingredients: (1) a cosmetically acceptable medium comprising water and optionally at least one organic solvent, and (2) at least one fluorescent dye comprised in said medium. No new matter is added by the present amendment, and support for the amendment can be found throughout the original specification and claims, *e.g.*, cancelled claims 20 and 70.

II. Allowable Subject Matter

Applicants thank the Examiner for indicating that claims 7-40 and 57-88 contain allowable subject matter and that claims 41-50 and 89-99 are allowed. However, Applicants maintain that the remaining pending claims, claims 1-6 and 51-56, are also patentable for at least the reasons set forth below, and therefore wish to continue prosecution of all the pending claims in this application at this time.

III. Rejection under 35 U.S.C. § 102(b)

The Examiner has rejected claims 51-56 under 35 U.S.C. § 102(b) as anticipated by U.S. Patent No. 4,256,458 to Degen et al. ("Degen") for the reasons disclosed at pages 2-3 of the present Office Action and for the reasons disclosed in the November 17, 2005 Office Action. Applicants respectfully traverse this rejection for at least the reasons presented below.

A rejection under § 102(b) is proper only when the claimed subject matter is identically described or disclosed in a single prior art reference. *In re Arkley*, 455 F.2d 586, 587 (C.C.P.A. 1972). In order to anticipate the claimed invention, a reference must

“teach every aspect of the claimed invention either explicitly or impliedly.” M.P.E.P. § 706.02 (emphasis added). Therefore, the absence of a single element or limitation indicates the reference neither describes nor anticipates the claim. M.P.E.P. § 2131.

The Examiner rejects claims 51-56, arguing that the fact that Degen teaches the claimed compound is sufficient to maintain an anticipation rejection. The Examiner argues that “in a cosmetically acceptable medium” and “at least one fluorescent dye present in an amount sufficient to dye keratin materials with a lightening effect” recite a utility of the compound, and therefore Degen anticipates the present claims, citing *In re Schoenwald*, 964 F.2d 1122 (Fed. Cir. 1992). See Office Action at 3.

The Applicants disagree. The Examiner’s reliance on *Schoenwald* is misplaced. The claims at issue in *Schoenwald* were compound claims, not composition claims. The present claims as amended recite a composition comprising “a cosmetically acceptable medium wherein said medium is water and optionally an organic solvent” and “at least one fluorescent dye present in an amount sufficient to dye keratin materials with a lightening effect, comprised in said medium.” The recitation of these ingredients (the medium and the dye) are not the recitation of a utility but rather of two specific elements of the claimed composition.

Thus, the Applicants respectfully submit that Degen fails to teach or disclose every aspect of the presently claimed composition. Specifically, Degen does not teach (1) “a cosmetically acceptable medium wherein said medium is water and optionally an organic solvent”; or (2) “at least one fluorescent dye present in an amount sufficient to dye keratin materials with a lightening effect, comprised in said medium.” Regardless of whether or not Degen discloses the presently claimed dye, without more, the

Examiner's rejection is improper because Degen fails to teach every aspect of the claimed composition, i.e., the medium and also the amount of dye present.

Accordingly, with respect to claims 51-56, Applicants submit that the Examiner has failed to demonstrate that the rejected claims are anticipated by Degen, and therefore request that the § 102(b) rejection be withdrawn.

IV. Rejection under 35 U.S.C. § 103(a)

The Examiner has rejected claims 1-6 under 35 U.S.C. § 103(a) as unpatentable over Degen for the reasons disclosed at pages 3-4 of the present Office Action and for the reasons disclosed in the November 17, 2005 Office Action. Applicants respectfully traverse this rejection for at least the reasons presented below.

In order to establish a *prima facie* case of obviousness, the Examiner must meet three basic criteria: (1) the prior art references, taken alone or in combination, must teach or suggest all of the claim limitations; (2) there must be some suggestion or motivation, either in the reference themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings; and (3) there must be a reasonable expectation of success. See M.P.E.P. §§ 2143.01-03. The Examiner "bears the initial burden of factually supporting any *prima facie* conclusion of obviousness." See *In re Fine*, 837, F.2d 1071, 1074, 5 U.S.P.Q.2d 1596, 1600 (Fed. Cir. 1988).

Here, Applicants respectfully submit that the Examiner has failed to establish a *prima facie* case of obviousness. The Examiner relies on Degen and argues that it would have been obvious to one of ordinary skill in the art to modify Degen to use the dye in a composition for keratin fibers. See Office Action at 4. The Applicants disagree.

Degen teaches methine dyes and claims a method for dyeing paper and anionically modified fibers. Degen is not analogous art and does not suggest using the claimed methine dyes in any application outside of dyeing paper and anionically modified fibers, and in no way suggests using the claimed methine dyes in a cosmetic method or application. Applicants respectfully submit that Degen does not teach or suggest a process for dyeing human keratin materials, let alone a process for dyeing human keratin materials with a lightening effect.

Further, Degen does not teach or suggest carrying out the claimed process with “a composition comprising, a cosmetically acceptable medium, wherein said medium is water and optionally an organic solvent and at least one fluorescent dye present in an amount sufficient to dye keratin materials with a lightening effect, comprised in said medium...” (see, e.g., claim 1 as amended). Degen does not provide any motivation to one of skill in the art to use the combination of the claimed dye, and a cosmetically acceptable medium, to dye human keratin material. As argued of record, even if one of skill in the art did use the methine dyes disclosed in Degen, in a cosmetically acceptable medium, to dye human keratin fibers, there could not possibly have been a reasonable expectation of success based on Degen’s disclosure alone, absent improper hindsight.

Accordingly, with respect to claims 1-6, the Examiner has failed to demonstrate that the rejected claims are obvious in view of Degen, and therefore request that the § 103(a) rejection be withdrawn.

V. Conclusion

Applicants respectfully requests that this Amendment under 37 C.F.R. § 1.116 be entered by the Examiner, placing all pending claims in condition for allowance.

Applicants respectfully submit that the proposed amendments do not raise new issues or necessitate the undertaking of any additional search of the art by the Examiner, since all of the elements and their relationships claimed were either earlier claimed or inherent in the claims as examined. Therefore, this Amendment should allow for immediate action by the Examiner.


In view of the foregoing amendments and remarks, Applicants respectfully request reconsideration of this application and the timely allowance of the pending claims.

Please grant any extensions of time required to enter this response and charge any additional required fees to Deposit Account No. 06-0916.

Respectfully submitted,

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By: 
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